REMARKS

Claims 47-79 are pending. No claims have been amended or cancelled.

Claim Rejections - 35 USC § 103 (Claims 60-66, 68-73 and 76-79)

The Examiner rejected claims 60-66, 68-73 and 76-79 under 35 USC § 103(a) as obvious from Hsu (USP 5,584,023) in view of Brundrett et al (USP 6,249,866). These rejections are respectfully traversed. Claims 60, 68, 69, 71, 76 and 77 are independent.

Hsu is directed to a computer system including a transparent and secure file transfer mechanism. In Hsu's computer system, all encryption and decryption is performed using a single algorithm.

Brundrett is directed to a file system which includes transparent file encryption and decryption capabilities.[1] Brundrett teaches that the user can choose among available encryption algorithms.

In rejecting claim 60, the Examiner did not explain how each and every limitation of the claimed method is shown in Hsu and Brundrett. Instead, the Examiner simply summarized the claimed invention as transparent file encryption. Although this generalization may be true, the Examiner has not made a *prima facie* showing of obviousness.[2] Claim 60 recites a number of steps not described, taught or suggested by Hsu or Brundrett. These steps include:

> generating a file identifier from the encryption key, an algorithm
> identifier associated with the selected algorithm and a data
> identifier associated with the file;
>
> adding the file identifier to the file; ...
>
> testing the encrypted data identifier after decryption by
> regenerating the encrypted data identifier and ascertaining that they

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[1] Brundrett is a 102(e) reference. It is believed that the invention claimed in at least some of the claims antedates Brundrett's filing date. Thus, it is expected that, if the Examiner does not allow the claims and relies upon Brundrett, a Rule 131 declaration will be filed to swear behind Brundrett.

[2] In the prior Office Action, the Examiner also referred to the claimed invention in general terms. The undersigned noted that the Examiner must show how each and every limitation in the claims was satisfied.

are the same.

The Examiner has not shown how Hsu or Brundrett disclose, teach or suggest these specific steps. In fact, these steps are not disclosed, taught or suggested by Hsu or Brundrett. The Examiner stated that Brundrett discloses a testing step. Though this is correct, Brundrett does not teach the claimed testing step. In Brundrett, an encrypted file includes a file encryption key (FEK) and an encrypted version of the FEK. Brundrett validates the integrity of the file by decrypting the encrypted version of the FEK and comparing it with the plaintext version of the FEK. In claim 60, an encrypted data identifier is regenerated and compared to the encrypted data identifier after decryption. Thus, not only has the Examiner not made a *prima facie* showing of obviousness, claim 60 is not obvious from Hsu in view of Brundrett.

Because claim 60 is allowable over Hsu and Brundrett, so are the claims dependent upon claim 60. However, the dependent claims are allowable on their own accord.

Claim 61 recites a "step of selecting the file from within the contents of a second file that is larger than the file." The Examiner stated that Hsu shows this step at column 6, line 1 to column 18, line 7. The Examiner has not shown how Hsu discloses the step – the Examiner has merely proposed a fishing expedition. However, there are no fish to catch – Hsu does not disclose teach or suggest the claimed step. Thus, the Examiner not made a *prima facie* showing of obviousness, and claim 61 is not obvious from Hsu in view of Brundrett.

The Examiner's rejection of claims 62-63 has even less basis. In claim 62, "the encrypted file is placed in a container." Claim 63 includes a "step of creating a third file from the second file wherein the third file contains the encrypted file and the portion of the second file that does not include the file." In rejecting these claims, the Examiner cited to column 6, lines 44-56 of Hsu. Yet, this section of Hsu merely describes basic features of the Unix operating system. Neither there, nor anywhere, does Hsu say anything relevant to these claims. The same argument applies to claims 64 and 66.

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Claims 68, 69, 71, 76, 77 and 78 are allowable for the same reason as claim 60, they include these recitations:

> generating a file identifier from the encryption key, an algorithm identifier associated with the selected algorithm and a data identifier associated with the file;
>
> adding the file identifier to the file;

Likewise, claims 68, 69, 71 and 79 are allowable because they recite:

> inputting a decryption key with a decryption key value;
>
> validating the decryption key value with the key value associated with the file identifier;

Claim Rejections - 35 USC § 103 (Claims 47-59, 67, 75 and 75)

The Examiner rejected claims 47-59, 67, 75 and 75 under 35 USC § 103(a) as obvious from Hsu in view of Brundrett and Finley (USP 5,815,571). Claims 47, 58, 59, 74 and 75 are independent.

Finley is directed to a computer system with secure data paths and a method of protection. Finley's object is to prevent harm from viruses, essentially by quarantining all incoming data before allowing the data to be moved to a normal workspace. Finley teaches that, instead of a single computer, there should be three computers: a main computer, a security computer and a test computer. Finley refers to the security computer as a "firewall." All security functions are implemented in the security computer, which "must not" execute user programs. Before a new program which has been downloaded from the Internet can be run on the main computer, it is first run on the test computer.

In rejecting claim 47, the Examiner did not explain how each and every limitation of the claimed method is shown in Hsu and Finley. Instead, the Examiner simply summarized the claimed invention as transparent file encryption plus virus scanning. Although this generalization may be true, the Examiner has not made a *prima facie* showing of obvious. Claim 47 recites a number of steps not described, taught or suggested by Hsu or Finley. These steps include:

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generating a file identifier from the encryption key, an algorithm
identifier associated with the algorithm and a data identifier
associated with the file;

adding the file identifier to the file;

Because these steps are not disclosed, taught or suggested by Hsu or Finley, claim 47 is not

obvious from these references.

The Examiner cited Finley as teaching "a computer system in which user programs are
executed in a location where embedded viruses can be detected transparent to the user." This
summary does not accurately portray Finley. Finley teaches that there should be three computers,
each having different responsibilities.

More importantly, Finley does not disclose, teach or suggest the one step of claim 47 against
which the Examiner cites it. That step recites, "invoking an option to initiate a virus scan program."
Finley's virus scan is automatic. Finley does not disclose, teach or suggestion any optional operation
– this would be contrary to Finley's objects.

In sum, Hsu and Brundrett do not disclose the encryption aspects of claim 47. Finley does
not disclose the virus scan aspects of claim 47. The two references together doe not disclose, teach
or suggest the method of claim 47. Claim 47 is therefore allowable.

The remaining claims have precisely the same differences discussed above with respect to
claims 47, 60, 62, 63 and 68. The Examiner has failed to make a *prima facie* case of obvious, and
cannot do so based upon the cited references. Withdrawal of the rejection is therefore mandatory.

Conclusion

There is simply no basis for rejecting the claims. Though the references may be relevant,
they simply do not alone or collectively show the claimed invention. The Examiner's failure to
address the arguments in the prior Response is unfair, and leaves the undersigned to simply guess at
why the prior rejections were withdrawn.

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The Examiner's repeated reliance upon Hsu and Finley references has now placed an unfair and unreasonable burden on the owner of the Application. Brundrett is also not a new reference, and the Examiner could have relied upon it earlier. In any case, the Examiner has once again not shown how the references disclose exactly each and every limitation of the claims. The Examiner's rejection of claims 60, 68, 69, 71, 76 and 77 was identical, but these claims are not identical. The Examiner's rejection of claims 47, 58, 59, 74 and 75 was identical, but these claims are not identical. The undersigned noted this defect with the prior Office Action as well.

It is further submitted that the independent and dependant claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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